

REMARKS/ARGUMENTS

Claims 25-69 are active in this application. Claims 68 and 69 find support in Claims 30 and 33 as well as the specification as originally filed. Claims 68 and 69 are directed to the elected species.

The Examiner contends that Claim 30 is generic for the water-soluble monomers and claim 33 is generic for the LCST units. Further, the Examiner citing PCT Rules 13.1 and 13.2 contends that the species do not relate to a single inventive concept because they lack the same or corresponding technical feature. Applicants disagree.

In the Office Action, the Examiner requires a selection of a species in Claims 50 or 56 and Claims 53 or 54. During a telephone discussion with the undersigned on July 29, 2004, the Examiner indicated that Applicant could elect any species listed in Claim 30 and Claim 33 provided that Applicants added corresponding dependent claims directed to those elected species. Claims 68 and 69 are directed to the elected species.

The Election Requirement is respectfully traversed. Applicants note that the PCT administrative instructions in the MPEP, Annex B, Part 1(f) define Markush practice and state that the alternatives defined in a single claim shall meet the technical relationship requirements of PCT Rule 13.2 if they are of a similar nature. These alternatives shall be regarded as being of a similar nature when the following criteria are fulfilled:

(A) all the alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The Office provides no support for its conclusion that the alternative chemical compounds in the claims are so dissimilar that they fail to meet the requirements of PCT Rule 13.2 for Markush practice. Applicants submit that criteria (A) and (B)(1) are met by the claims and that they are of similar nature as that term is defined in Annex B above.

Applicants further traverse the Restriction Requirement on the ground that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the international application and examined all claims together. Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirement relating to the form and contents of the international application different from or additional to those which are provided for the Patent Cooperation Treaty and the Regulations. In light of PCT Article 27(1) and 37 C.F.R. §145 and §1.499, it is apparent that when the International Preliminary Examination Authority finds no objection based on lack of unity of invention, there is a special burden on the Office to explain why its conclusions are diametrically opposed to those of the International Preliminary Authority, as approved by treaty.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together. More significantly, the Examiner has already searched the claims as shown by the Office Action mailed to the Applicants on January 22, 2004.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Election of Species Requirement. Withdrawal of the Election of Species Requirement is respectfully requested.

With respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Respectfully submitted,

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